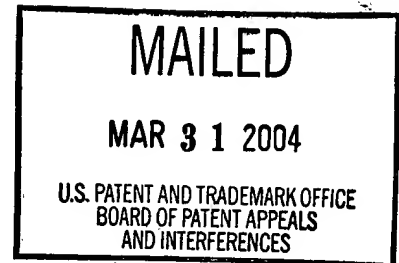


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte JAMES A. WESTHOFF and JAMES A. KELLY

Application No. 09/395,106

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on March 8, 2004. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

Appellant's filed an After Final Amendment on November 18, 2002 (Paper No. 14). In the Advisory Action mailed December 16, 2002 (Paper No. 16), the Examiner indicated that the Amendment

would be entered after a Notice for Appeal has been filed. A review of the file indicates that the Amendment was not physically entered.

The following problems occur in the Examiner's Answer mailed April 8, 2003. Appropriate correction of the following defects is required.

In the Group of claims, page 2 of the Examiner's Answer, the examiner indicates that claims 27 and 45 are both cancelled and rejected. A supplemental Examiner's Answer, indicates the correct status of these two claims is required.

On page 5 of the Examiner's Answer the Examiner rejected claim 41 under 35 U.S.C. § 102(b) as being anticipated by Brooks. The Examiner's Answer fails to address the rejection of claim 21-26, under 35 U.S.C. § 102(b) as being anticipated by Brooks. A supplemental Examiners Answer is needed, indicating the status of claims 21-26.

On page 5 of the Examiner's Answer, the Examiner rejects claim 27 under 35 U.S.C. § 103(a) as being unpatentable over Ditcher in view of Peacock and Sawdon et al. However, as noted above the Examiner's Answer also lists claim 27 as being cancelled. Appropriate correction is required.

Lastly, a review of the Examiner's Answer, reveals that information contained therein pertaining to the required appeals conference is not in compliance with the Manual of Patent Examining Procedure (MPEP)

§ 1208 (8th ed., rev. 1, Feb. 2003).

According to MPEP § 1208:

The participants of the appeal conference should include (1) the examiner charged with preparation of the examiner's answer, (2) a supervisory patent examiner (SPE), and (3) another examiner, known as a conferee, having sufficient experience to be of assistance in the consideration of the merits of the issues on appeal.

On the examiner's answer, below the primary examiner's signature, the word "Conferees:" should be included, followed by the type or printed names of the other two appeal conference participants. These two appeal conference participants must place their initials next to their name. This will make the record clear that an appeal conference has been held.

The Examiner's Answer was not initialed or signed by the conferee's as required under MPEP § 1208.

Accordingly, it is

ORDERED that the application is returned to the examiner to:

1) physically enter the Amendment dated November 18, 2002 (Paper No. 14);

2) vacate the Examiner's Answer dated April 8, 2003 (Paper No. 20);

3) issue a new Examiner's Answer setting clearly setting forth all pertinent rejections;

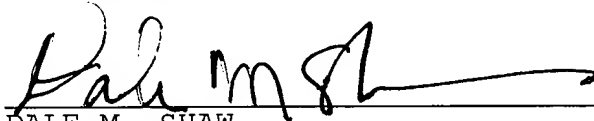
4) correction of the Examiner's Answer to acknowledge the appeals conference, by identifying the names, initials and/or signatures of all conferee's;

5) that this application be retained in Technology Center 3600 for two months after mailing of the new Examiner's Answer as to permit appellants to respond to the new Examiner's Answer;

6) for such further action as appropriate.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS
AND INTERFERENCES

A handwritten signature in dark ink, appearing to read 'Dale M. Shaw', is written over a horizontal line.

DALE M. SHAW
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DMS/dpv
RA04-0362

Application No. 09/395,106

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